

## **REMARKS**

1. In response to the Office Action mailed November 19, 2008, Applicant respectfully requests reconsideration. Claims 1-14, 24-26, and 29-30 were last presented for examination. In the outstanding Office Action, claims 1-8, 10-14, 24-26 and 29 were rejected. By the foregoing Amendments, claims 1, 6, 10, 13, 24 and 26 have been amended, claim 30 has been cancelled and no claims have been added. Thus, upon entry of this paper, claims 1-14, 24-26 and 29 will be pending in this application. Of these eighteen (18) claims, 3 claims (claims 1, 24 and 26) are independent.
2. Based upon the above Amendment and following Remarks, Applicant respectfully requests that all outstanding objections and rejections be reconsidered, and that they be withdrawn.

### ***Allowable Subject Matter***

3. Applicant thanks the Examiner for indicating that claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form to include all of the limitations of its base and any intervening claims.

### ***Claim Rejections under 35 U.S.C. §112, Second Paragraph***

4. The Examiner has rejected claim 30 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, the Examiner asserts that claim 30 is indefinite for combining two statutory classes because claim 1 is directed to an apparatus while claim 30 is allegedly directed toward a method for identifying conductors using direct visualization. Applicant has cancelled claim 30 thereby rendering this rejection moot.

### ***Claim Rejections under 35 U.S.C. §102 and §103***

5. The Examiner has rejected claims 1-8, 10-11, 13-14, 24-26 and 29-30 under 35 USC 102(b) as being anticipated by U.S. Patent No. 5,824,026 to Diaz, (hereinafter, "Diaz"). The

Examiner has also rejected claim 12 under 35 U.S.C. §103(c) as being unpatentable over Diaz. Applicant respectfully disagrees.

***Claim 1***

6. Diaz is directed to a catheter having layers of stranded electrically conductive fibers to deliver electrical energy to a patient. (See, Diaz, col. 1, lns. 6-10.) Each layer comprises a plurality of fibers which follow spiral or helical non-overlapping paths between the ends of the catheter. (See, Diaz, col. 2, ln. 65- col. 3, ln. 3.) “Since the fibers do not overlap, they can be closely or maximally packed together in a layer which approximates a cylindrical shell conductor,” thereby providing an outer surface useful for making electrical contact with, and delivering electrical current to, a patient. (See, Diaz, col. 3, lns. 3-18; emphasis added.) The catheter of Diaz is particularly useful “when the wires are stranded so closely together that they are in contact with the immediately adjacent fibers.” (See, Diaz, col. 8, lns. 36-46.) The catheter of Diaz may comprise multiple such stranded layers. (See, Diaz, FIGS. 4-5, col. 5, lns. 25-65.)

7. Applicant’s claim 1 is directed to an “electrically conducting lead comprising... a plurality of layers each having a plurality of electrical conductors extending there through, wherein a second end of a conductor is identifiable as corresponding to a first end of the conductor based on the position of said second end with respect to the positions of said second ends of said other conductors.” (See, Applicant’s claim 1, above; emphasis added.) In the outstanding Office Action, the Examiner asserts that the conductive fibers of Diaz are configured to be separate channels and are allegedly separated by insulating fibers. (See, Office Action, pg. 5.) The Examiner then asserts that because “each of the fibers is configured to be a single channel[,] each is inherently identifiable from each other at each end of the lead.” (See, Office Action, pg. 5; emphasis added.) This conclusion by the Examiner fails to show how Diaz anticipates or renders obvious Applicant’s claimed invention.

8. Applicant’s specification explains that prior art conducting leads use a plurality of wires helically wrapped around a length of an insulative body. (See, Applicant’s specification, pg. 2, ln. 14- pg. 3, ln. 14.) The helically arranged wires are then used to conduct electrical signals along the length of the lead. (See, Applicant’s specification, pg. 2, ln. 14- pg. 3, ln. 14.) However, this prior art helical arrangement makes it difficult to associate a first end of a wire

with a second of the wire. (See, Applicant's specification, pg. 3, lns. 16-23.) It is difficult to associate the ends of the wires to one another because the wires all follow parallel helical paths over the length of the lead and all terminate in substantially similar positions. "As such, following formation of the lead, it is a time consuming process to individually test each wire" to identify each wire. (See, Applicant's specification, pg. 3, lns. 16-23.)

9. As noted above, Diaz uses the prior art helical arrangement referenced in Applicant's specification. (See, Diaz, col. 3, lns. 3-18; FIG. 4.) As such, Applicant asserts that Diaz must suffer from the same drawbacks as the conducting leads described in Applicant's specification. Specifically, it would not be possible to identify a second end of a conductor of Diaz "as corresponding to a first end of the conductor based on the position of said second end with respect to the positions of said second ends of said other conductors." As shown in FIGS. 4 and 5, the position of Diaz's conductors does not permit association of the two ends of a conductor because the stranded fibers follow non-overlapping parallel helical paths, and are closely or maximally packed together. (See, Diaz, col. 2, ln. 65- col. 3, ln. 18.) Applicants assert that mere separation of such helically arranged conductors would not overcome the above described problems and, as such, would not "inherently" permit identification of conductor so as to associate the ends of the conductor to one another.

10. There is no disclosure in Diaz indicating that the stranded layers have any type of structure permitting "a second end of a conductor [to be identified] as corresponding to a first end of the conductor." (See, Applicant's claim 1, above.) However, as noted, the Examiner asserts that because "each of the fibers is configured to be a single channel[,] each is inherently identifiable from each other at each end of the lead." (See, Office Action, pg. 5; emphasis added.) Applicant respectfully request that the Examiner explain in detail how this "inherent identification" is possible "based on the position of [a] second of a conductor with respect to the positions of... second ends of said other conductors." Applicant particularly requests that the Examiner reconcile the provided conclusory statement with Applicant's specification illustrating that Diaz's prior art helical arrangement makes the claimed identification difficult.

11. For at least the reasons detailed above, Applicant asserts that Diaz fails to anticipate or render obvious the invention recited in claim 1. Therefore, Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. §102 be reconsidered, and that it be withdrawn.

***Claim 24***

12. Applicant's claim 24 is directed to an "electrically conducting lead comprising... an electrically conductive element wound around a length of said elongate body comprising a plurality of layers each having a plurality of electrical conductors extending there through... further wherein said plurality of electrical conductors are positioned within said conductive element such that a second end of a conductor is identifiable as corresponding to a first end of the conductor based on the position of said second end with respect to the positions of said second ends of said other conductors." (See, Applicant's claim 24, above; emphasis added.) As detailed above with reference to claim 1, Diaz fails to anticipate or render obvious "wherein said plurality of electrical conductors are positioned within said conductive element such that a second end of a conductor is identifiable as corresponding to a first end of the conductor based on the position of said second end with respect to the positions of said second ends of said other conductors" as recited, in part, in claim 24. Therefore, Applicant respectfully requests that the rejection of claim 24 under 35 U.S.C. §102 be reconsidered, and that it be withdrawn.

***Claim 26***

13. Applicant's claim 26 is directed to an "electrically conducting lead comprising... an electrically conductive element helically wound around a length of said elongate having first and second ends and comprising a plurality of layers, each said layer having a plurality of electrical conductors positioned therein such that the position of each of said plurality of conductors with respect to said other conductors remains constant between said first and said second ends of said insulative body, and wherein each of said plurality of conductors are positioned such that the second end of a conductor is identifiable at said second end of said conductive element as corresponding to a first end of a conductor based on the position of said second within said conductive element with respect to the positions of said second ends of said other conductors." (See, Applicant's claim 26, above; emphasis added.) As detailed above with reference to claim 1, Diaz fails to anticipate or render obvious "the position of each of said plurality of conductors with respect to said other conductors remains constant between said first and said second ends of said insulative body, and wherein each of said plurality of conductors are positioned such that the second end of a conductor is identifiable at said second end of said conductive element as

corresponding to a first end of a conductor based on the position of said second within said conductive element with respect to the positions of said second ends of said other conductors" as recited, in part, in claim 26. Therefore, Applicant respectfully requests that the rejection of claim 26 under 35 U.S.C. §102 be reconsidered, and that it be withdrawn.

***Dependent Claims***

14. The dependent claims incorporate all the subject matter of their respective independent claims and add additional subject matter which makes them independently patentable over the art of record. Accordingly, Applicant respectfully asserts that the dependent claims are also allowable over the art of record.

***Conclusion***

15. In view of the foregoing, this application should be in condition for allowance. A notice to his effect is respectfully requested.

16. Applicant makes no admissions by not addressing any outstanding rejections or basis of rejections. Furthermore, Applicant reserves the right to pursue any cancelled claims or other subject matter disclosed in this application in a continuation or divisional application. Thus, cancellations and amendments of above claims, are not to be construed as an admission regarding the patentability of any claims.

Dated: February 19, 2009

Respectfully submitted,

\_\_\_\_\_  
/Michael G. Verga/  
Michael G. Verga  
Registration No.: 39,410  
CONNOLLY BOVE LODGE & HUTZ LLP  
1875 Eye Street, NW  
Suite 1100  
Washington, DC 20006  
(202) 331-7111  
(202) 293-6229 (Fax)  
Attorney for Applicant